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**JAN 28 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Joseph H. Sklar :  
Application No. 09/612,055 :  
Filed: July 7, 2000 :  
Attorney Docket No. SKLAR-21

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on November 15, 2004, to have fees refunded.

The petition is **DISMISSED**.

The record reflects that on June 2, 2004, a final Office action was mailed allowing a shortened statutory period for reply of three months from its mailing date. The next response, on record as having been received on November 15, 2004, included a Request for Continued Examination, Request for an Extension of Time within the third month, and the instant petition. Petitioner requests a refund of the fees associated with the Request for Continued Examination (RCE), extension of time, and the instant petition fee because petitioner maintains that the RCE was only necessary to save the application from abandonment because the amendment that was mailed August 2, 2004, was lost in the mail.

It is noted that 37 CFR 1.26, governing refunds, states that:

[t]he Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for oral hearing, will not entitle a party to a refund of such fee.

There is nothing in the instant petition to suggest that the fees were mistakenly paid. The payment of the fees was quite deliberate as they were paid with the intention of keeping the application from going abandoned. While it is regretful that the amendment was allegedly lost by the United States Postal Service (USPS), petitioner is not entitled to a refund of the fees paid to the USPTO for alternate filings necessitated by the mistake of USPS, but which applicant deemed necessary to properly prosecute the application.

It is further noted, that rather than filing an RCE upon realizing that the amendment has not been received, petitioner had the option of timely filing the amendment via 37 CFR 1.8 or 1.10—and even filing an RCE to be considered only if the amendment was determined not to place the application in condition for allowance. Yet, petitioner chose to file the RCE, presumably to avoid the possibility that the amendment would not have placed the application in condition for allowance and the application still going abandoned. While petitioner certainly has the right to prosecute the application in this way,

petitioner is not entitled to a refund when petitioner makes a deliberate choice to file what amounted to a preemptive and precautionary RCE. Petitioner is, therefore, not entitled to a refund of the fee for the RCE, or the fee for the extension of time, or the fee for the instant petition. The petition is dismissed, accordingly.

The application file will be directed to Technology Center 3700, GAU 3732 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned (571) 272-3222.



Kenya A. McLaughlin

Petitions Attorney  
Office of Petitions